



Paper No. 3

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In re Application of
Lauffer et al.
Application No. 08/942,989
Filed: October 2, 1997
Attorney Docket No. MET - 7
For: CONTRAST-ENHANCED
DIAGNOSTIC IMAGING METHOD FOR
MONITORING INTERVENTIONAL
THERAPIES

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OFFICE OF PETITIONS

In re Application of
Lauffer et al.
Application No. 09/887,706
Filed: September 8, 2000
For: CONTRAST-ENHANCED
DIAGNOSTIC IMAGING METHOD FOR
MONITORING INTERVENTIONAL
THERAPIES

DECISION GRANTING PETITION
AND
ASSIGNMENT OF APPLICATION
NUMBER AND NOTICE OF
OMITTED ITEMS

This is a decision on the petition under 37 CFR 1.10(d) filed September 29, 2000, requesting that a continuation application of application No. 08/942,989, be accorded a filing date of September 8, 2000, rather than the presently accorded filing date of September 11, 2000. The petition is properly treated under 37 CFR 1.10(c).

Petitioners allege the application was deposited in Express Mail service on September 8, 2000. In support, the petition is accompanied by Express Mail receipt No. EM390216125US (the same Express Mail number found on the original application papers located in the official file) showing a "date-in" of September 8, 2000.

In view of the above, the petition is granted.

The transmittal letter accompanying the application papers filed on September 8, 2000, indicates that an application under 37 CFR 1.53(b) was being filed. The application papers were **not** in any way designated as a CPA filing under 37 CFR 1.53(d). However, the Office erroneously processed the application as a Continued Prosecution Application (CPA) under 37 CFR 1.53(d). Since the application was processed as a CPA, it was assigned the application number of the prior application. Thereafter, a non-final Office action was mailed in application No. 08/942,989 on October 10, 2000. On April 13, 2001, an amendment was filed. A second non-final Office action was mailed on May 29, 2001, and on November 29, 2001, a response was submitted by facsimile. A confirmation copy of the response submitted on November 29, 2001, along with references, was received on December 17, 2001.

Since the transmittal letter clearly indicated that the application was being filed under 37 CFR 1.53(b), the application papers filed September 8, 2000, must be processed as an application under 37 CFR 1.53(b). Accordingly, the application papers filed on September 8, 2000, including the transmittal letter, specification including claims, declaration, small entity statement, and preliminary amendment, have been removed from application No. 08/942,989 and have been assigned a new application number, application No. **09/887,706**. All further communications concerning the continuation application filed on September 8, 2000, should be directed to that application number.

A Notice of Appeal was filed on February 15, 2000, in application No. 08/942,989. A petition for a five month extension of time with the requisite fee was filed on September 8, 2000. Since no appeal brief was filed within the time prescribed by 37 CFR 1.192, the appeal stands dismissed. Because of the dismissal of the appeal, application No. 08/942,989 is **abandoned** because there are no allowed claims. The non-final Office actions mailed on October 10, 2000, and May 29, 2001, were sent in error and are hereby **vacated**. The Office actions will be retained in application No. 08/942,989, but, because application No. 08/942,989 was abandoned prior to the mailing of such Office actions, they are of no effect. See *Lorenz v. Finkl*, 333 F.2d 885, 142 USPQ 26 (CCPA 1964). The amendments filed on April 13, 2001 and November 29, 2001 in response to those Office actions will likewise be retained in application No. 08/942,989. A copy of the transmittal letter for the continuation application and the preliminary amendment filed therewith have also been retained in application No. 08/942,989 in order to complete the record therein.

A review of the application papers filed September 8, 2000, reveals that Figures 1-3 described in the specification appear to have been omitted from the application. 35 USC 113, first sentence states, "the applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." The application, as filed, includes method claims. It is the current practice of the U.S. Patent and Trademark Office to accept an application having a process or a method claim which is filed without a drawing. Since claims 36-63 are method claims, which by

Office practice do not require a drawing for filing date purposes, the application is entitled to a filing date of September 8, 2000.

As per MPEP 601.01(f), a nonprovisional application having at least one claim directed to subject matter for which a drawing is usually not considered essential for a filing date, which describes drawing figure(s) in the specification but which is filed without drawings, will be treated as an application filed without all of the drawing figures referred to in the specification as discussed in MPEP 601.01(g).

A review of the postcard receipt for the filing of the application, which accompanied the petition, reveals that no sheets of drawings were listed as being among the items being filed. Furthermore, it is noted that the transmittal letter, while only evidence of what was intended to be filed, did not indicate that any sheets of drawings were being filed even though a check box was available to indicate if drawings were being filed.

I. Should applicant contend that the omitted drawings were in fact deposited in the USPTO with the application papers, a petition accompanied by the \$130.00 petition fee (37 CFR 1.17(h)) with evidence of such deposit must be filed within **TWO MONTHS** of the date of this Notice. The petition fee will be refunded if it is determined that the drawings were received by the USPTO.

II. Should applicant desire to supply the omitted drawings and accept the date that such omitted drawings were filed in the USPTO as the filing date of the above-identified application, the omitted drawings (with a supplemental oath or declaration in compliance with 37 CFR 1.63 and 1.64 referring to such drawings), and a petition under 37 CFR 1.182, accompanied by the \$130.00 petition fee (37 CFR 1.17(h)), requesting the later filing date must be filed within **TWO MONTHS** of the date of this Notice.

III. The failure to file a petition (and petition fee) under the above options (I) or (II) within **TWO MONTHS** of the date of this Notice will be treated as constructive acceptance by the application of the application as deposited in the USPTO. **THIS TWO MONTH PERIOD IS NOT EXTENDABLE UNDER 37 CFR 1.136(a) or (b).** In the absence of a timely filed petition in reply to this Notice, the application will maintain a filing date as of the date of deposit of the application papers in the USPTO, and the original application papers (i.e., the original disclosure of the invention) will include only those application papers present in the USPTO on the date of deposit.

In the event that applicant elects not to take action pursuant to options (I) or (II) above (thereby constructively electing option III), amendment of the specification to cancel all references to any omitted drawings is required. Such amendment should be by way of preliminary amendment submitted prior to the first Office action to avoid delays in the prosecution of the application.

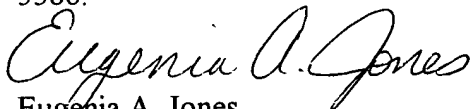
A courtesy copy of this decision is being mailed to the address contained in the "Revocation and New Power of Attorney" filed in application No. 08/942,989 by facsimile on November 29, 2001. No further communications regarding application No. 09/887,706 will be mailed to such address unless a new power of attorney is filed in application No. 09/887,706.

After mailing of this decision, Office records will be corrected to show that filing fees (\$345.00 basic filing fee, \$72.00 for 8 claims in excess of 20, and \$130.00 multiple dependent claim fee) paid on September 8, 2000, were paid in application No. 09/887,706, not in application No. 08/942,989.

Application No. 08/942,989 is being returned to Technology Center Art Unit 1619 for further processing as an abandoned application. As noted above, since an appeal brief was not timely filed, the appeal stands dismissed and the application is abandoned because there are no allowed claims. The amendment filed November 29, 2001, will not be entered or considered by the examiner.

Application No. 09/887,706 is being forwarded to Initial Patent Examination Division for further processing as a continuation application under 37 CFR 1.53(b) with a filing date of **September 8, 2000**, using the application papers filed on that date and to await any reply to the Notice of Omitted Items. If no reply is timely filed within **TWO MONTHS** of this Notice, then the application will be forwarded to the technology center. The PALM bib-data sheet will indicate that 0 sheets of drawings were present on filing.

Telephone inquiries specific to this matter should be directed to the undersigned at (703)306-5586.



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